

II. Remarks

Reconsideration and allowance of the subject application is respectfully requested.

Claims 7, 9-10, 15-18, 20, 23-27, 29-34, and 36-45 are pending in the application.

Claims 7, 15, 24, 31, and 45 are independent.

Inventor Peter Walcot and his U.S. counsel Rick Bauer would like to thank Examiner Barnie for the cordial and productive interview of July 7, 2004. The Examiner's helpful comments and suggestions were instrumental in preparing this response.

Claims 7-10 and 15-37 were rejected as being unpatentable over Woynoski, Muehlberger, Keil, Risafi, and Fougnies, for the reasons noted at pages 2-8 of the Office Action. Applicants respectfully traverse all art rejections. Applicants respectfully traverse all art rejections.

As discussed at the interview, a notable feature according to the present invention is the ability of the host server to vend (through its coupled POSs or ATMs) second PINs from a plurality of telephone service providers. Since each telephone service provider typically provides its second PINs in a unique format, the second PINs must be stored on the host server in a common form so that the second PINs from any telephone service provider may be provided through the associated POSs or ATMs. See, for example, the embodiment described in the paragraph bridging pages 22-23 of the specification:

In yet a further preferred embodiment, where it is desired to give a patron a choice of telephone service providers 30 to choose from (e.g., telephone service provider A ("Telco A"), telephone service provider B ("Telco B"), etc., etc., as well as a choice of pre-paid time from each telephone service provider 30, a plurality of groups of second PIN numbers from each Telco A, B, etc. are provided to the ATM 12 or the network host computer 22 interfacing with such ATM 12 or POS terminal 13 in the manner previously described, each group corresponding to a series of second PIN numbers corresponding to pre-paid service which would be supplied by a particular telephone service provider. For example, second PIN numbers associated with Telco A may have an "A" prefix, while those second PIN numbers associated with Telco B may have a "B" pre-fix or suffix. Each of the second PIN numbers in a particular group are sub-divided into sub-groups, with each second PIN number in a particular sub-group providing a pre-paid quantity of telephone time, with the pre-determined quantity of time associated with second PIN numbers within one sub-group being different from the pre-determined quantity of time associated with second PIN numbers within another of the sub-groups. For example, as may be seen from Fig. 2, a patron is give a choice of telephone service providers 30 (Telco A, Telco B, etc), and in respect of each telephone service provider a choice of three pre-determined quantities of telephone time (\$10, \$20, and \$30), prior to be thereafter being asked to select the desired mode of payment.

As discussed at the interview, each of independent Claims 7, 15, 24, 31 and 45 recites a novel, non-obvious combination of steps including, *inter alia*, the steps of (i) causing the second PIN numbers (ascribed by the plurality of telephone service providers) to be supplied to the host server in a common form, and (ii) causing said second PIN numbers to be stored in the common form on the host server. In contrast, none of the cited art, whether taken individually or in combination, discloses or suggest such a combination of steps including those discusses above. Accordingly, the salient claimed features of the present invention are nowhere disclosed or suggested by the cited art.

As also discussed at the interview, Applicants respectfully traverse the prior art rejections on the ground that the only motivation shown on the record for combining the references in the manner proposed is Applicants stated motivation, and thus impermissible hindsight reconstruction.

To prevent such hindsight reconstruction, the law is clear that a *prima facie* case of obviousness can be established **only** by showing some **objective** teaching in the cited art which would lead an individual of ordinary skill in this art to combine the relevant references. *See Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Patent Office Board of Appeals 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined **only** if there is some suggestion or incentive to do so. The mere fact that the prior art may be modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1578, 221 USPQ 929, 933 (Fed. Cir. 1984). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Hindsight combination of references is not a valid basis for rejection under 35 U.S.C. §103, *In re Adams*, 148 U.S.P.Q. 742 (CCPA 1966) and *In re Skoll*, 187 U.S.P.Q. 481, 484 (CCPA 1975). Further, in *Twin Disc Inc. v. United States*, 10 Cl. Ct. 713; 231 U.S.P.Q. 417, 425 (Cl. Ct. 1986), the Court stated:

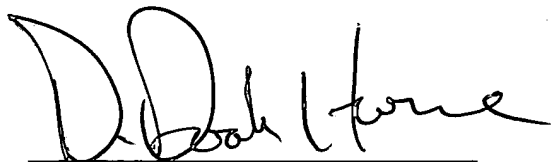
... it is now clear beyond cavil that it is not permissible to ascertain factually what the inventors did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the claimed invention.

Citing *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012; 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983), the Court in *Twin Disc* further stated that it is incorrect to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Accordingly, it is respectfully requested that the rejections of record be withdrawn.

In view of the above amendments and remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney Richard P. Bauer, Reg. No. 31, 588 may be reached by telephone at (202) 625-3507 and D. Doak Horne, Reg. No. 33,105 may be reached at (403) 298-1994. All correspondence should continue to be directed to the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Doak Horne", written over a horizontal line.

Attorney for Applicants
D. Doak Horne, Reg. No. 33,105

D. Doak Horne, Reg. No. 33,105
Gowling Lafleur Henderson, LLP
Suite 1400, 700 - 2nd Street, S.W.
Calgary, Alberta T2P 4V5